

Application Serial No.: 10/066,985  
Filing Date: February 2, 2002

Reply to Office action of: November 21, 2005  
Attorney Docket No.: YOR920010745US1

### **REMARKS**

This Amendment is in response to the Office Action of November 21, 2005. Applicants respectfully submit that all the claims presently on file are in condition for allowance or appeal. Applicants have amended the claims to more clearly point out the present invention.

### **THE CLAIMS**

#### **REJECTION UNDER 325 USC 103**

Claims 1-7, 10-12, 14-18, and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over ScanWise 2.00 Printout (hereinafter "Printout"), in view of Ferguson et al., US 6,810,404 B1 (hereinafter "Ferguson"). Claims 8-9, 13, and 18-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Printout in view of Ferguson and Anderson et al., US 2001/0054106 A1 (hereinafter "Anderson").

Applicants respectfully submit that the cited references do not disclose all the elements and limitations of the claims on file as a whole. Consequently, the claims on file are not obvious under 35 U.S.C. 103, and the allowance of these claims is earnestly solicited. The allowability of the rejected claims will now be discussed in view of representative claim 1.

Applicants agree with the Examiner that "[P]rintout does not explicitly disclose index values to assist in storing the document and to further assist in searching for, and locating the document based on the document

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content."

The Printout reference generally relates to a method of scanning a document for creating an electronic image of the document. This electronic image of the document (e.g., scanned object) can be re-used in other applications.

However, the Printout reference does not describe an electronic cover that includes data related to the content of the document. Rather, the cover page described in Printout includes properties of the scanned document, which properties are related to the characteristics of the electronic image, such as grey-scale, rotation, color, etc., but not the content of the document.

The Examiner responded to this argument by pointing out that "Printout's cover page includes data, such as grey-scale, rotation, color. Because grey-scale, rotation, color are used to form the document, these data related to the content of the document. It is noted that the electronic cover is an electronic web form or a electronic cover sheet and "business information related to the content of the document" are not claimed." Emphasis added.

Applicants submit that the following properties: grey-scale, rotation, and color, should not be considered as "content" of the document, but should be viewed as describing "the appearance" of the document. The distinction is akin to the distinction between content and context. Claim 1

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has now been amended to clarify that the document content includes critical data elements. Claims 8-13 clarify the meaning of the term content.

In response to the Examiner's assertion that "business information related to the content of the document" are not claimed, Applicants respectfully submit that claims 8-13 exemplify some of the meaning of business information, and thus business information is actually claimed.

Thus, contrary to Printout, the cover sheet of the present system (as recited in representative claim 1) is intended to hold business information related to the content of the document. The present system reads this business information from the cover sheet, validates this information, and stores it. The stored business "content" information could be automatically re-used as index values, in order to store the electronic document itself, and further to search for the document. It also enables the automatic reuse of the business data related to the electronic document itself (i.e., content) into other applications, thus preventing any retypes and minimizing typing errors.

In addition, Printout uses the properties of the electronic image of the document but does not make use of the actual content of the document. More specifically, the document properties are not related to the document content (e.g., the business values of the picture or words inside the document).

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Furthermore, the document properties in Printout are do not qualify as **dynamic content data elements that reflect updates to the document content**. As explained earlier, the properties in Printout do not relate to the content of the document.

Moreover, claim 1 clarifies that the populated data in the cover sheet, which relate to the content of the document, could be used to store, search, and locate the document. Contrary to the present invention, Printout does not use the content of the document as part of the document properties, to store, search, and locate the document.

In addition, claim 1 has been amended to clarify that the **electronic cover is** an object that is **separate from the document and that is added to the image of the document**. As stated by the Examiner, "grey-scale, rotation, color [in Printout] are used **to form the document**". Thus, contrary to the present invention, the **Printout properties do form part of the document image and do not form a separate entity** that is useable in other applications. Thus, in essence, Printout teaches away from the present invention.

The following illustration clarifies the present invention and exemplifies some of its distinctive features over Printout. The present invention allows a cover to be added to the image of the document. The cover holds business data related to the content of the document image. As an example, the cover according to the present invention holds the following exemplary business information:

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Customer name: "Cakes"  
Customer Address: "4724 Edwards Street"  
Customer City: "Alexandria, Virginia 22312"

The values of the customer name, address, and city are validated, that is checked with related customer records application, whether this customer exists or not. If the customer does not yet exist, the present system automatically creates a workflow, re-using the values of customer name, address, and city, by automatically re-using/inserting those values in the related customer records application as entry for a new customer to be registered. Contrary to the present invention, Printout is not capable of using this content related information.

The present invention enables the reuse of the same values (e.g., customer name, address, etc.) in a related CRM system, ensuring that, for example, a customer relations manager writes a letter back to the customer, advising the customer that the phone number provided by the customer, is incomplete.

In summary, the cover of the present invention is intended to hold business information related to the content of the document, enabling the present method to read this business information from the cover, to validate it, to store it, and to automatically reuse this business information as meta-data (e.g., index values), in order to store the electronic document itself (the first page, being the actual document itself) and to enable finding the document in the future. Though some of the aspects listed in this

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paragraph are not expressly recited in claim 1, they are used as examples for a clearer understanding of the invention.

As a result, Applicants respectfully submit that **Printout does not consider the present invention as a whole.**

The Examiner resorts to Ferguson as describing certain attributes of the document. However, similarly to Printout, Ferguson does not describe the present invention as a whole in that Ferguson does not teach the steps of claim 1, particularly that the attributes of Ferguson do not qualify as content related attributes as explained earlier in connection with Printout. More specifically, **the attribute data of Ferguson**, such as "document size, document type (color, black and white or gray scale), orientation, brightness, resolution for scanning a document (Ferguson, figures 1, 5-7; col.9, lines 39-65)" **are not content related data** as recited in the instant claim 1.

As a result, the hypothetical combination of Printout and Ferguson will not consider the present invention as a whole, necessitating the finding of non-compliance with the foregoing legal standard. Reference is made to the following legal authority in support of the finding of non-obviousness:

**"In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.** The prior art perceived a need for mechanisms to dampen resonance, whereas

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the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700."

In support of the combination of Printout and Ferguson, the Examiner states as follows:

"It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Ferguson's teaching into Printout's teaching to provide search features, since the combination would have allowed the user searching a document based on data relate to the document such document attributes as Ferguson disclosed."

Applicants respectfully submit that Ferguson does not provide any teaching or suggestion to support modifying the Printout design to generate an electronic cover that "is an object that is separate from the document and that is added to the image of the document, wherein the data elements includes critical data elements, and wherein the electronic cover is used to validate the critical data elements related to the document", as recited in claim 1.

The Examiner provided a general reason for the desirability of the combination of Printout and Ferguson, in hindsight, without referring to any substantive (or significant) teaching or suggestion in Ferguson in support of such combination. More specifically, the reason provided by the Examiner is generic and insufficiently specific.

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As a result, The Examiner has not met the prima facie burden of supporting the obviousness rejection under 35 USC 103, and the hypothetical combination of Printout and Ferguson cannot be used to support a finding of obviousness, as indicated by the legal authorities below:

**"Obviousness cannot be established** by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion** supporting the combination." *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). **What a reference teaches** and whether it teaches toward or **away from the claimed invention** are questions of fact. See *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984)."

"When a rejection depends on a combination of prior art references, there must be **some teaching, suggestion, or motivation** to combine the references. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). **Obviousness can only be established by combining or modifying** the teachings of the prior art to produce the claimed invention **where there is some teaching, suggestion, or motivation** to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

Claim 1 is thus not obvious in view of Printout and Ferguson and the allowance of this claim and the claims dependent thereon, is earnestly solicited. Independent claims 14 and 20 are allowable for containing a similar subject matter to that of claim 1. Therefore, claims 14 and 20 and the claims dependent thereon, are also allowable.



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**CONCLUSION**

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

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Respectfully submitted,



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